

#13
6/7/03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANTS: Eric P. ORGERON, et al. DATE: April 10, 2003

SERIAL NO.: 09/779,169 GROUP ART UNIT: 3643

FILED: 8 February 2001 EXAMINER: Susan L. Piascik

FOR: "Fishing Lure"

ATTORNEY DOCKET NO.: A99274US (98062.3)

* * * * *

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES
BRIEF OF APPELLANT

Board of Patent Appeals and Interferences
Commissioner of Patents and Trademarks
Washington, D.C. 20231

Dear Sirs:

On October 2, 2002, the Examiner finally rejected Claims 9, 18-24, and 26-40 of the above-referenced patent application. A Notice of Appeal was filed on 3 February 2003, and was received by the USPTO on 10 February 2003. This brief, required by 37 C.F.R. § 1.192(a), is due on 10 April 2003 (see 37 C.F.R. § 1.8(a)(2) and MPEP § 512 (Eighth Edition First Revision (E8R1) 02/2003)); it is in the form required by 37 C.F.R. § 1.192(c).

CERTIFICATE OF MAILING

I hereby certify that **the original and two copies** of this Appeal Brief are being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231, on April 10, 2003.


Seth M. Nehrbass, Reg. No. 31,281

RECEIVED
2003 APR 15 AM 9:42
BOARD OF PATENT APPEALS
AND INTERFERENCES

(1) REAL PARTY IN INTEREST:

The real party in interest is Eric P. ORGERON.

(2) RELATED APPEALS AND INTERFERENCES:

There are no related appeals or interferences.

(3) STATUS OF CLAIMS:

Claims 1-8, 10-17, and 25 have previously been cancelled. Claims 9, 18-24, and 26-40 are pending. Claim 9 was rejected under 35 U.S.C. § 102(e) as being clearly anticipated by Preston. Claims 18-24, 26, 27, 31-34, 39, and 40 were rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Brokaw. Claims 28-30 and 35-38 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Brokaw in view of Preston.

The rejection of Claims 9, 18-24, and 26-40 is being appealed.

(4) STATUS OF AMENDMENTS:

No amendments have been filed after the final rejection.

(5) SUMMARY OF INVENTION:

As suggested by MPEP § 1206, Applicant has read some of the appealed claims on the specification and drawings. These claims follow.

9. Apparatus (see Figure 1 and page 5, line 5 through page 6, line 8) for making a sound similar to the slapping or clicking noise that a live shrimp makes when the tail section of the live shrimp makes contact with its body section, comprising:

a float 17 slidably received on a rod 20;

a first magnet 15 attached to the float 17;

a second magnet 22 attached to the rod, the first and second magnets being aligned such that they repel one another (see page 5, lines 21-28).

18. (amended) A fishing lure 1 (see Figure 1) for use in water with a fishing line, the fishing lure comprising:

an artificial bait body 10 having a tail; and

a weighted tube means 13 in the artificial bait body for allowing a line 9 to pass from the tail of the artificial bait body through the tube means and for causing the artificial bait body to be at a level position

in the water while hanging on a fishing line (see page 4, lines 6-8).

(6) ISSUES:

- (i) (There are no 35 U.S.C. § 112, first paragraph rejections.)
- (ii) There are no 35 U.S.C. § 112, second paragraph rejections.)
- (iii) Is Claim 9 patentable over Preston under 35 U.S.C. § 102(e)? Are Claims 18-24, 26, 27, 31-34, 39, and 40 patentable over Brokaw under 35 U.S.C. § 102(b)?
- (iv) Are claims 28-30 and 35-38 patentable over Brokaw and Preston under 35 U.S.C. § 103(a)?

(7) GROUPING OF THE CLAIMS:

The rejected claims do not stand or fall together. Based on the references cited and arguments made by the Examiner, the claims are grouped together in particular combinations in part (8) for convenience. Applicant reserves the right to regroup the claims or to argue the patentability of each claim individually should new references be cited or new arguments or rejections be made.

(8) ARGUMENT:

- (i) (There are no 35 U.S.C. § 112, first paragraph rejections.)
- (ii) There are no 35 U.S.C. § 112, second paragraph rejections.)
- (iii) Claim 9 is patentable over Preston under 35 U.S.C. § 102(e). Claims 18-24, 26, 27, 31-34, 39, and 40 patentable over Brokaw under 35 U.S.C. § 102(b).

Claim 9 was rejected under 35 U.S.C. § 102(e) as being clearly anticipated by Preston. Applicant respectfully traverses this rejection. First, the fish lure of Preston is not a float as claimed. No where in Preston is it stated that the lure floats. Just because there is apparently a void space does not mean that it floats - there is no disclosure that this apparent void space is filled with air - it could be filled with liquid or open to the outside so water can fill it (one cannot assume that it is a water-tight void space). Second, the fish lure of Preston is not slidingly received on a rod; it is instead rotatably received on a rod. Thus, Preston neither anticipates nor renders obvious claim 9.

Claims 18-24, 26, 27, 31-34, 39, and 40 were rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Brokaw.

Brokaw's design with a tubular member extending angularly upward and outward from the middle portion of the lure body towards the head section of said body which would create about a 20° incline

passage way that would place the line entrance port of said tube at the farthest forward point in the lure body predisposing his design to hang in a vertical position in the water, thereby negating the lure's ability to mimic the natural position of live bait which is generally in a horizontal position. Although Brokaw teaches a body comprising an opening forward of the tail and generally between the head and tail his design does not anticipate that a weighted tubular member placed in a vertical position in the head section of the lure body provides an effective counter balancing mechanism that offsets the weight that is applied to the lure body by placing the hook at or near the tail position of said body. Claim 18 includes the limitation that there be a weighted tube means in the artificial bait body for allowing a line to pass from the tail of the artificial bait body through the tube means and for causing the artificial bait body to be at a level position in the water while hanging on a fishing line. This limitation is neither disclosed nor suggested by Brokaw. That Brokaw's tube in Figure 4 could be metal or plastic does not mean that it is weighted. It could be made of either material and still not be weighted. Thus, Brokaw cannot be said to anticipate these claims.

Brokaw's design with a tubular member extending angularly upward and outward to the farthest point of the head section does not consider that a space must be allotted for a means of attachment of a whisker in the forwardmost position in the lure body. Claim 33 now specifically claims whiskers, so it is not anticipated by Brokaw, nor is it rendered obvious by Brokaw.

(iv) Claims 28-30 and 35-38 patentable over Brokaw and Preston under 35 U.S.C. § 103(a)

Claims 28-30 and 35-38 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Brokaw in view of Preston. This rejection is respectfully traversed.

Claim 28 is not rendered obvious by Brokaw and Preston. The device of Preston is a stand-alone lure, not intended to be used with another lure. It would not be obvious to add the device of Preston to the device of Brokaw. Even if one did, one would not have the invention as claimed in claims 29, 30, 36, 37, or 38, as the device of Preston is not a float.

All claims dependent on claim 18 are believed to be patentable by virtue of such dependence.

CONCLUSION:

For the foregoing reasons, applicant respectfully submits that all claims remaining in the application are allowable. A Notice of Allowance is hereby respectfully requested.

TELEPHONE CONFERENCE INVITATION:

Should the Examiner or any member of the Board feel that a telephone conference would advance the prosecution of this application, he is encouraged to contact the undersigned at the telephone number listed below.

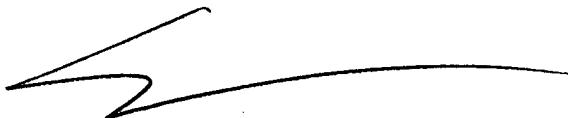
PETITION FOR EXTENSION OF TIME:

Applicant hereby petitions the Commissioner under 37 C.F.R. § 1.136 for any extension of time necessary to render this Appeal Brief timely filed, and asks that the fee for any such extension be charged to Deposit Account No. 50-0694.

FEES:

A \$ 160.00 check for the fee required by 37 C.F.R. § 1.192(a) and § 1.17(f) is enclosed. Please charge any additional fees due or credit any overpayment to Deposit Account No. 50-0694.

Respectfully submitted,



Seth M. Nehrbass, Reg. No. 31,281
Charles C. Garvey, Jr., Reg. No. 27,889
Gregory C. Smith, Reg. No. 29,441
Stephen R. Doody, Reg. No. 29,062
Brett A. North, Reg. No. 42,040
GARVEY, SMITH, NEHRBASS & DOODY, L.L.C.
PTO Customer No. 22920
3838 N. Causeway Blvd., Suite 3290
Metairie, LA 70002
Tel.: (504) 835-2000
Fax: 504-835-2070
e-mail: IPLNO@AOL.COM
www.neworleanspatents.com

P:\Seth\98062.3Appeal.Brief.wpd

(9) APPENDIX:

CLAIMS ON APPEAL:

9. Apparatus for making a sound similar to the slapping or clicking noise that a live shrimp makes when the tail section of the live shrimp makes contact with its body section, comprising:

a float slidingly received on a rod;

a first magnet attached to the float;

a second magnet attached to the rod, the first and second magnets being aligned such that they repel one another.

18. (amended) A fishing lure for use in water with a fishing line, the fishing lure comprising: an artificial bait body having a tail; and

a weighted tube means in the artificial bait body for allowing a line to pass from the tail of the artificial bait body through the tube means and for causing the artificial bait body to be at a level position in the water while hanging on a fishing line .

19. (twice amended) The fishing lure of claim 18, further comprising:

a line passing from the tail of the artificial bait body through the weighted tube means.

20. (twice amended) The fishing lure of claim 18, wherein:

the artificial bait body has a head;

the weighted tube means in the artificial bait body is positioned forward of the tail, generally in between the head and the tail;

the lure further comprises a flexible fishing line or leader having first and second ends, a first end being attached to the tail of the artificial bait body, the line or leader passing through the weighted tube means, wherein:

the second end of the line or leader is connected to a fishing reel or to a length of fishing line wound upon the reel.

21. The fishing lure of claim 20, wherein:

the line is a section of leader that has first and second ends, a first end attached to the tail, and the second end defining a point of attachment for attaching a user's rod/reel thereto.

22. (amended) The fishing lure of claim 18, further comprising a hook attached to the lure body.

23. (amended) The fishing lure of claim 18, further comprising a hook attached to the line.

24. (amended) A method of fishing using the lure of claim 18 to catch fish.

26. (amended) The fishing lure of claim 18, wherein the artificial bait body is an artificial shrimp body.

27. The fishing lure of claim 26, further comprising:

a line passing from the tail of the artificial shrimp body through the tube means.

28. (amended) A fishing lure comprising:

an artificial bait body having a tail;

an opening in the artificial bait body for allowing a line to pass from the tail of the artificial bait body through the opening; and

sound-making means for making a sound similar to the slapping or clicking noise that a live shrimp makes when the tail section of the live shrimp makes contact with its body section.

29. The fishing lure of claim 28, wherein the sound-making means comprises a float having a magnet thereon.

30. The fishing lure of claim 28, wherein the sound-making means comprises:
a float means slidingly received on a rod means;
a first magnet attached to the float means;
a second magnet attached to the rod means, the first and second magnets being aligned such that they repel one another.

31. (amended) The fishing lure of claim 18, wherein the artificial bait body is an artificial shrimp body and the tube means is a tube for allowing a line to pass from the tail of the artificial shrimp body through the tube.

32. The fishing lure of claim 31, further comprising:
a line passing from the tail of the artificial shrimp body through the tube.

33. (amended) The fishing lure of claim 18, wherein the artificial bait body is an artificial shrimp body and includes whiskers.

34. (amended) The fishing lure of claim 33, further comprising:
a line passing from the tail of the artificial shrimp body through the tube means.

35. The fishing lure of claim 34, further comprising:
a sound-making means for making a sound similar to the slapping or clicking noise that a live shrimp makes when the tail section of the live shrimp makes contact with its body section.

36. The fishing lure of claim 35, wherein the sound-making means comprises a float having a magnet thereon.

37. The fishing lure of claim 35, wherein the sound-making means comprises:
a float means slidingly received on a rod means;
a first magnet attached to the float means;
a second magnet attached to the rod means, the first and second magnets being aligned such that they repel one another.

38. The fishing lure of claim 35, wherein the sound-making means comprises:
a float slidingly received on a rod means;
a first magnet attached to the float;
a second magnet attached to the rod means, the first and second magnets being aligned such that they repel one another.

39. (amended) The fishing lure of claim 28, further comprising:
a tube means in the opening for allowing a line to pass from the tail of the artificial bait body through the tube means.

40. The fishing lure of claim 39, further comprising:
a line passing from the tail of the artificial bait body through the tube means.